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DATE: May 9, 2003 COVER SHEET & 3 PAGE(S)CLIENT NUMBER: 10829-8610-US0000RETURN TO: (NAME) Steve Whelan (EXT.) 3209 (ROOM No.) 4195ORIGINAL DOCUMENT(S) WILL BE: ☐ SENT TO YOU ☒ HELD IN OUR FILES

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Examiner Sana A. Al-Hashemi	U.S. Patent and Trademark Office	(703) 305-4881	(703) 746-9098

in re Application of: Hoyt A. Fleming, III and Paul A. Revis
Application No.: 09/526,910
Filed: 16 March 2000
For: METHOD AND APPARATUS FOR CONTROLLING
REPRODUCTION OF AN AUDIOVISUAL WORK
Confirmation No.: 1414
Art Unit: 2171

Enclosure:

Response to Office Action dated 22 April 2003 (3 pages)

I hereby certify that this correspondence is being transmitted via facsimile to the United States Patent and Trademark Office at (703) 746-9098, attention Examiner Sana A. Al-Hashemi, on:

Date: May 9, 2003By: Stephen P. Whelan
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PeyAttorney Docket No. 108298610US
Disclosure No. MUEI-0528

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Date: May 9, 2003By: Stephen P. Whelan

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Fleming *et al.*

APPLICATION No.: 09/526,910

FILED: 16 March 2000

FOR: **METHOD AND APPARATUS FOR
CONTROLLING REPRODUCTION
OF AN AUDIOVISUAL WORK**

EXAMINER: Sana A. Al-Hashemi

ART UNIT: 2171

CONFIRMATION No: 1414

RECEIVED

MAY 09 2003

Response to Office Action

Technology Center 2100

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The present communication responds to the Office Action mailed 22 April 2003 in this case. In that Office Action, the Examiner stated that the Preliminary Amendment filed with the Continuing Prosecution Application (CPA) on 24 February 2003 was improper and giving applicant one month to respond. In particular, the Examiner stated:

The amendment filed on 3/3/03 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention.

In the Remarks section of the Preliminary Amendment, however, the undersigned specifically stated the intention to pursue "Group II" and acknowledged that the present invention cancelled the claims drawn to "Group I." The Remarks also called the Examiner's attention to the provisions of MPEP §819, which states:

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Where a continued prosecution application (CPA) filed under 37 CFR 1.53(d), is a continuation of its parent application and not a divisional, or where a File Wrapper Continuation (FWC) filed under former 37 CFR 1.62, is a continuation of its parent application and not a divisional or C-I-P, an express election made in the prior (parent) application in reply to a restriction requirement carries over to the CPA or FWC application **unless otherwise indicated by applicant**. In no other type of continuing application may an election carry over from the prior application.

Where there is no indication in the CPA or FWC application that a change in election is desired, the examiner's first action should include a repetition of the restriction requirement made in the prior application to the extent it is still applicable in the CPA or FWC application and a statement that prosecution is being continued on the invention elected and prosecuted by applicant in the prior application. **Examples of what is meant by the phrase "otherwise indicated by applicant" would be where the CPA or FWC is filed as (A) a divisional or (B) a continuation and includes an amendment filed prior to first action in the CPA or FWC adding claims to an invention not previously elected.** In each of these examples the examiner should make a new restriction requirement in the first action.

MPEP §819 (8th Ed., Rev. 1), emphasis added.

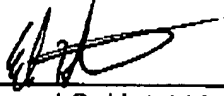
The Preliminary Amendment, filed before the first Office Action in this CPA, added claims drawn to "an invention not previously elected," i.e., claims drawn to Group II. In addition, the body of the Remarks section explicitly stated the intention to pursue previously non-elected Group II. Accordingly, the undersigned respectfully submits that the Preliminary Amendment indicated that the election in the parent application is not intended to carry over to the current CPA and the Preliminary Amendment should, therefore, be entered.

If the undersigned has misunderstood the Office's rules or if the Examiner believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at 206.264.3848.

Attorney Docket No. 108298610US
Disclosure No. MUEI-0528

Respectfully submitted,
Perkins Coie LLP

Date: 9 May 03



Edward S. Hotchkiss
Registration No. 33,904

Correspondence Address:

Customer No. 25096
Perkins Coie LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 583-8888

claim, it is bound to withdraw the requirement and to act on all linked inventions. But once all linking claims are canceled 37 CFR 1.144 would not apply, since the record would be one of agreement as to the propriety of restriction.

Where, however, there is a traverse on the ground that there is some relationship (other than and in addition to the linking-type claim) that also prevents restriction, the merits of the requirement are contested and not admitted. Assume a particular situation of process of making and product made where the claim held linking is a claim to product limited by the process of making it. The traverse may set forth particular reasons justifying the conclusion that restriction is improper where the process necessarily makes the product and there is no other present known process by which the product can be made. If restriction is made final in spite of such traverse, the right to petition is preserved even though all linking claims are canceled.

818.03(e) Applicant Must Make Own Election

Applicant must make his or her own election. The examiner will not make the election for the applicant. 37 CFR 1.142, 37 CFR 1.143, second sentence.

819 Office Generally Does Not Permit Shift

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter.

Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right). When claims are presented which the examiner holds are drawn to an invention other than the one elected, he or she should treat the claims as outlined in MPEP § 821.03.

Where the inventions are distinct and of such a nature that the Office compels restriction, an election is not waived even though the examiner gives action upon the patentability of the claims to the nonelected invention. *Ex parte Loewenbach*, 1904 C.D. 170, 110 O.G. 857 (Comm'r Pat. 1904) and *In re Waugh*, 135 F.2d 627, 57 USPQ 371 (CCPA 1943).

Where a continued prosecution application (CPA) filed under 37 CFR 1.53(d), is a continuation of its parent application and not a divisional, or where a File Wrapper Continuation (FWC) filed under former 37 CFR 1.62, is a continuation of its parent application and not a divisional or C-I-P, an express election made in the prior (parent) application in reply to a restriction requirement carries over to the CPA or FWC application unless otherwise indicated by applicant. In no other type of continuing application may an election carry over from the prior application.

Where there is no indication in the CPA or FWC application that a change in election is desired, the examiner's first action should include a repetition of the restriction requirement made in the prior application to the extent it is still applicable in the CPA or FWC application and a statement that prosecution is being continued on the invention elected and prosecuted by applicant in the prior application. Examples of what is meant by the phrase "otherwise indicated by applicant" would be where the CPA or FWC is filed as (A) a divisional or (B) a continuation and includes an amendment filed prior to first action in the CPA or FWC adding claims to an invention not previously elected. In each of these examples the examiner should make a new restriction requirement in the first action.

819.01 Office May Waive Election and Permit Shift

While applicant, as a matter of right, may not shift from claiming one invention to claiming